

REMARKS

In the Office Action under reply, claims 1-12 were rejected under 35 USC 103 as being obvious in view of U.S. Patent 6,658,401, issued December 2, 2003 to Utsumi (the present applicant) and Yoneyama. No other rejection is set out in the Office Action.


MPEP § 706.02(k) states that

“[e]ffective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention ‘were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.’ This change to 35 U.S.C. § 103(c) applies to all utility design, and plant applications filed on or after November 29, 1999...”

At the time the present invention was made, the Utsumi ‘401 patent was subject to an obligation of Assignment, and in fact was assigned, to Sony Corporation. Similarly, the instant application was under an obligation to, and has in fact been assigned to Sony Corporation as evidenced by the recordation of such assignment with the USPTO on August 31, 2001 at Reel 012131, Frame 0598. The Utsumi ‘401 reference meets the criteria to be considered a reference under 35 U.S.C. § 102(e) and has been assigned to Sony Corporation, the same assignee as the instant application. Consequently, the Utsumi ‘401 reference cannot properly be considered a reference under 35 U.S.C. § 103(a), as 35 U.S.C. § 103(c) expressly disqualifies such a reference from “precluding patentability.” Accordingly, without Utsumi ‘401, it is respectfully requested that the above rejection of claims 1-12 be withdrawn.

It is respectfully submitted that this application now is in condition for allowance. Early notice to that effect is requested.

Respectfully submitted,
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